

Albrecht, B.

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REMARKS

Claims 1-42 are pending in the present application. In the Office Action mailed March 10, 2005, the Examiner rejected claim 35 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner next rejected claims 1-11, 14-15, 22-26, and 23-42 under 35 U.S.C. §103(a) as being unpatentable over Kikuchi et al. (USP 5,250,786), taken with Japanese document no. JP4-356372A. Claims 3-8, 11-13, 16-21, 24-31, and 38-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kikuchi et al. taken with the Japanese document no. JP4-356372A, and further in view of Paul et al. (USP 5,198,698).

Before addressing the claim rejections, Applicant notes that claims 1 and 22 have been amended to add the conjunctive "and" that, due to a typographical error, was inadvertently omitted. The amendments have been made to improve readability and in no way limit the scope of claims.

The Examiner rejected claim 35 under §112, second paragraph, as being indefinite because the claim is an apparatus claim that depends from a method claim. Applicant has amended claim 35 to correct the typographical error identified by the Examiner. As such, claim 35 now properly depends from claim 22. As such, Applicant believes claim 35 is in full compliance with the requirements of §112.

The Examiner rejected claims 1-11, 14-15, 22-26, and 23-42 as unpatentable over Kikuchi et al. in view of Japanese document no. JP4-356372A ('372 Patent Abstract). These claims include three independent claims and numerous dependent claims having varying scopes and elements; but, nevertheless, the Examiner failed to address the individual elements of the claims and instead rejected claims 1-11, 14-15, 22-26, and 23-42 in a single stroke. Therefore, Applicant will address the general remarks provided by the Examiner with respect to the rejection of claims 1-11, 14-15, 22-26, and 23-42; however, Applicant believes that upon proper consideration of each and every element of the claims, it is clear that the proffered combination does not teach or suggest the claimed invention.

When rejecting claims 1-11, 14-15, 22-26, and 23-42 as unpatentable over Kikuchi et al. in view of the '372 Patent Abstract, the Examiner cited Figs. 1 and 2 and columns 3-6 of Kikuchi et al. as teaching all elements of claims 1-11, 14-15, 22-26, and 23-42 except a power source housing. However, the Examiner concluded, "This difference does not patentably distinguish over the prior art" because "it would have been obvious to have provided the system of Kikuchi et al. (5,250,786) with the housing claimed, the motivation being the teaching of the Japanese document no. JP4-35372A that it is advantageous to include an engine/generator and battery

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welding power supply in a housing (see the housing associated with element 57 in figures 3-9 of the Japanese document no. JP4-356372A)."

Applicant respectfully disagrees with the Examiner's conclusion. The claimed invention is not merely a combination of an engine-driven welder and a battery-driven welder. That is, Kikuchi et al. teaches an independent battery-driven welder 10 and an independent engine-driven welder 20 that are merely connected together by a switch 30. Figures 1 and 2 as well as the accompanying description thereof are clear that "[t]he battery-driven welder 10 and the engine-driven welder 20 are separate d-c arc welders" and that "numeral 20 refers to an engine-driven welder, and 10 to a battery-driven welder; both being provided individually." Col. 4, lns. 55-58 and col. 5, lns. 4-7 (emphasis added). Therefore, Kikuchi et al. teaches directly away from arranging the engine-driven welder and the battery-driven welder in the same housing because such would render the welder to no longer be "provided individually" or "separately." As such, Kikuchi et al. clearly teaches away from an internal combustion engine and an energy storage device in a common power source housing. That is, MPEP §2141.02 is clear that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *Citing* W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Accordingly, the '372 Patent Abstract cannot be combined with Kikuchi et al. as proposed by the Examiner because, under MPEP §2145, "[i]t is improper to combine references where the references teach away from their combination." *Citing* In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). That is, as asserted by the Examiner, the abstract of the '372 Patent explains, as shown in Fig. 7, that "[a]n engine welding machine 55 and a battery welding machine 56...are stored in a box 57." Therefore, the '372 Patent Abstract teaches that the engine-driven welder and the battery-driven welder are not "both being provided individually," as required by Kikuchi et al. Col. 5, lns. 4-7. Therefore, the combination proposed by the Examiner is impermissible under MPEP §§ 2141.02 and 2145.

Additionally, the '372 Patent provided by the Examiner is a Japanese language patent. Accordingly, only the Abstract of the '372 Patent is in English. Applicant would like to remind the Examiner that rejections based on abstracts are generally considered improper. MPEP §706.02. As is widely recognized, abstracts are commonly misleading, inaccurate, and incomplete. As such, MPEP §706.02 is clear that abstracts should only be relied upon in very limited circumstances. Specifically, "[i]n limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract

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only without relying on the full text document.” *Id.* In these limited circumstances, “the full text document and a translation (if not in English) may be supplied in the next Office action.” *Id.* As such, should the Examiner find the above remarks unpersuasive, Applicant hereby requests the Examiner provide an English translation of the full text of JP4-356373A with any subsequent action relying upon such.

Also, as identified by the MPEP, “[a]n abstract can have a different effective publication date than the full text document.” MPEP §706.02. As such, Applicant hereby disputes that the Abstract of JP4-356373A is valid prior art. Therefore, should the Examiner persist in relying upon the Abstract of JP4-356373A, the Examiner must proffer proof of the effective date of the Abstract independent the effective date of the full text of JP4-356373A.

Notwithstanding the Examiner’s reliance on a combination of references that lack the requisite motivation or suggestion to combine, the references also fail to teach or suggest that which is claimed. As such, Applicant believes that claims 1-11, 14, 15, 22-26, and 32-42 are patentably distinct from the art of record.

The Examiner also rejected claims 3-8, 11-13, 16-21, 24-31, and 38-40 under 35 U.S.C. §103. As claim 16 is the only independent claim, the following remarks will be limited to the subject matter of claim 16. With respect to claim 16, the Examiner relied upon a combination Kikuchi et al. and the ‘372 Patent Abstract and then added Paul et al. because, as the Examiner acknowledged, the combination of Kikuchi et al. and the ‘372 Patent Abstract fails to teach or suggest “various control features dealing with configuration change timings and various sensors associated with controlling the internal combustion engine.” As addressed above, Applicant does not believe the combination of Kikuchi et al. and the ‘372 Patent Abstract is proper because 1) Kikuchi et al. teaches away from the proposed combination and 2) the ‘372 Patent Abstract should not be relied upon as prior art since it is merely an abstract that may be misleading, inaccurate, and incomplete and which may have an unverifiable publication date. Accordingly, notwithstanding the teachings of Paul et al., the Examiner’s rejection of claim 16 cannot be sustained.

Further, with respect to the rejection of claims 3-8, 11-13, 17-21, 24-31, and 38-40, Applicant respectfully disagrees with the Examiner with respect to the art as applied, but in light of these claims depending from what are believed otherwise allowable claims, Applicant does not believe additional remarks are necessary and therefore requests allowance of claims 3-8, 11-13, 17-21, 24-31, and 38-40, at least pursuant to the chain of dependency.

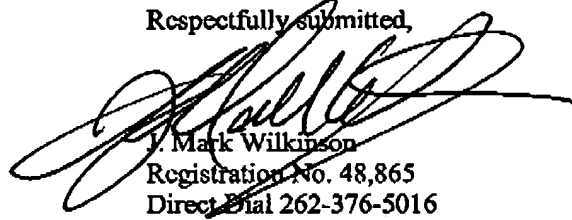
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Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-42.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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